

## **REMARKS**

### **Related Application**

This application is relate to copending application Serial No. 11/042, 442, filed January 26, 2005.

### **Amendments**

The amendments to the specification merely correct obvious typographical errors regarding the term "hexahydrothiopyranyl" and the name of compound 47. See, e.g., the formulas illustrating compounds 34, 37, 47, and 68 at pages 131, 134, and 137 and the synthesis of compounds 47 and 34, 37, and 68 in Examples 16 and 28, respectively.

Claims 1-24, 27-32, 34, 36, 37, 43, 44, 48, and 49 are cancelled. Claims 25, 26, 33, 35, 38-42, and 45-47 now depend directly or indirectly from new independent compound claim 50.

New claims 50-101 are directed to a further aspect of applicants' invention. See, e.g., page 7, lines 24-30, page 10, lines 15-17, page 12, lines 13-15, Examples 15, 16, 28, and 34, and Compounds 13, 15, 16, 25, 46, 47, 50, 51, 59, 60, 61, 73, 76, 78, 79, and 85-89.

New independent claim 99 and its dependent claims 100 and 101 are directed to a further aspect of applicants' invention. See, e.g., Examples 24 and 28, and Compounds 6, 13, 15, 16, 25, 34, 37, 40, 42, 46-49, 52, 63, 65, 66, 68, 70, 71, 74-78, 81-83, and 86-90.

### **Election**

In response to the Election, applicants hereby elect Group II. Group II is defined as thienyl compounds of the formula wherein group Z is a cyclohexyl group. Applicants' new independent compound claim 50 defines group Z as being a cyclohexyl group, and, thus, claim 50 and the compound claims dependent thereon read on the elected invention. New compound claims 99-101 also encompass compounds wherein group Z is a cyclohexyl group, and thus also read on the elected invention.

With respect to the election of species, applicants hereby elect 5-(4-FLUORO-PHENYL)-3-[(4-HYDROXY-CYCLOHEXYL)-(4-METHYL-CYCLOHEXANE-CARBONYL)-AMINO]-THIOPHENE-2-CARBOXYLIC ACID, which is designated as compound 50 in the specification. See, e.g., page 21, lines 14-16 and page 133, last

compound. Claims 50-60, 67, 74, and 84-97 read on the elected species.

However, the Restriction is respectfully traversed. In the Restriction, the Examiner sets forth three compound groups, i.e., Groups I-III. However, this Restriction of Groups I-III, improperly seeks to restrict within a single claim, e.g., claim 1. Applicants respectfully submit that 35 USC §121 does not permit restriction within a single claim as clearly indicated by the court in *In re Weber et al.*, 198 USPQ 328 (1978).

As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits.

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It is apparent that §121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular claim on that same basis. [*Weber* at 331-332]

The effect of restriction within a single claim is the same as a rejection. 35 USC §121 does not give the Commissioner authority to require that a single claim "be divided up and presented in several applications" and thus deny the Applicant the right to have that single claim considered on its merits. This is exactly the action that the Court in *Weber* stated was not permitted under 35 USC §121. Such action by an Examiner would violate "the basic right of the Applicant to claim his invention as he chooses." [*Weber* at 332]

The claims here are Markush claims. MPEP §803, entitled "Restriction - When Proper," states that "[i]nsofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria are set forth in MPEP §803.02." The latter section of the MPEP states that: "[s]ince the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention."

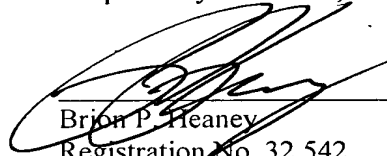
Thereafter, the MPEP cites *In re Harnish*, 206 USPQ 300 (CCPA 1980) and *Ex parte Hozumi*, 3 USPQ2d (Bd. Pat. App. & Int. 1984). These two cases both deal with improper Markush rejections. Thus, in the case of Markush claims, refusal by the Office to examine that which the applicants regard as their invention must be a refusal based on an improper Markush rejection. No such rejection has been made.

In view of the above remarks, examination as to Groups I -III should proceed in accordance with MPEP §803.02.

As for Groups IV-VI, upon determination that the compound subject matter is allowable, applicants will request rejoinder of the claims of Groups IV-VI, pursuant to MPEP §821.04.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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